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IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No. 857

CHARLES J. HIRSCH, *Petitioner*

v.

DAVID L. LADD, Commissioner of Patents, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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Charles J. Hirsch prays that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals, entered in the above-entitled case on October 25, 1961. The decision upon which said judgment is based was given in an opinion dated October 25, 1961. A petition for rehearing was denied on January 12, 1962.

CITATIONS TO OPINION BELOW

The opinion (Item IX)* of the Court of Customs and Patent Appeals was reported in 295 F(2) 251;

* Throughout this petition references to Roman numeral "Items" are to Items I to XVII in the Certified Record of the United States Court of Customs and Patent Appeals accompanying this petition.

49 CCPA (Patents) 745, 131 USPQ 198. A copy of the opinion is printed herein as Appendix A.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered October 25, 1961 (Item X). A Petition for Rehearing (Item XI) of the decision in an opinion (Item IX) dated October 25, 1961 was denied January 12, 1962 (Item XVI). The jurisdiction of this Court is invoked under 28 USC Section 1256 (Appendix B).

QUESTIONS PRESENTED

A. What is the meaning of 35 USC 112 which is of imperative public importance to the scientific and industrial community in its deep concern with the validity of patents for inventions? What did Congress wish it to do in describing inventions? What did Congress wish the Patent Office not to do?

A-1. Contrary to decisions of this Court, may the plain command of 35 USC 112 that a patent specification describe an invention so as to "enable any person skilled in the art to which it pertains * * * to make and use the same," be so enlarged by the Court of Customs and Patent Appeals and the Patent Office as to force upon an inventor the added burden that a challenged capability of a described, well known engineering tool must be established by

1. being found in a printed publication;
2. being of known conventional nature;
3. being spelled out as to component values;
4. being so disclosed that those skilled in the art need not have to design circuitry.

A-2. Where an inventor who is an acknowledged expert in his art, unchallenged as to credibility, has sworn to the ability of those skilled in his art to construct a common engineering tool, from examples which he identified in the professional literature, may he be deprived of his statutory right to a patent by an arbitrary assertion of a Patent Office examiner of unknown expert status that he knows of no such tool, particularly where the examiner does not even explain his doubt, nor why the inventor's assertion is supposedly erroneous, nor attack the inventor's credibility.

STATUTE INVOLVED

The statutory provision involved is the first paragraph of 35 USC 112, which directs what a patent specification shall contain, and reads as follows:

> "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention".

STATEMENT

Following an appeal from the Board of Appeals of the United States Patent Office in accordance with 35 USC 141, a five judge Court of Customs and Patent Appeals in a majority opinion of three judges, accompanied by dissents of two judges (Item IX), failed to answer the first (A) of the foregoing questions and answered the second (A-1) and third (A-2) in the affirmative. Petition for Rehearing was denied (Item

XVI), as well as Petitioner's Motion to Correct for Diminution of the Record (ItemXII) to add irrelevant portions of the Patent Office proceedings to remove a cloud created by prejudicial insinuations that relevant parts of the record were missing—portions which it was the duty of the Patent Office to produce instead of raising the cloud. (On this subject, see also page 5 of Item XI, Items XIII, XIV and XV).

On July 28, 1954, petitioner filed in the United States Patent Office his application Serial No. 446,301, for a patent on his invention (TRANSCRIPT OF RECORD, Item I, pages 3 to 15).

The invention relates to a color television system and, in particular, to a combination of well known engineering tools for the purpose of overcoming a special problem in the tool (picture tube) upon which the picture is actually seen. To go into the nature of color television systems in general or into Petitioner's particular system in any further detail would only confuse the issue since the issue is confined to a very specific point, namely, the sufficiency of disclosure of the element 25 (TRANSCRIPT OF RECORD, Item I, Pages 7 and 15) which is designated a "Sampling Sawtooth Signal Generator", a common engineering tool.

FOR THE FIRST TIME in a "FINAL" rejection*, dated June 6, 1957 (Item I, pages 17, 18) the Examiner raised the objection that the generator 25 was not sufficiently described in respect to its required capability of functioning at a frequency of 2 megacycles.

* In the Patent Office "Final" Rejection informs the applicant inventor that the Examiner has made his decision and that the inventor's remedy is by appeal to the Board of Appeals. Opportunity for further argument with the Examiner is extremely limited.

Prior to that the Examiner asserted only grounds of rejection which were later withdrawn; those parts of the Patent Office proceedings were omitted as irrelevant in subsequent proceedings. With regard to the Examiner's thus belated ground of rejection concerning the capability of generator 25 to function at a 2 megacycle frequency, he said in the "FINAL" rejection:

> "The specification is further deficient in the disclosure of the structure of the generator. The use of rectangles indicates that any apparatus of the type named in the rectangle may be inserted therein without modification. Applicant's disclosure however requires that the sawtooth oscillator operate at two megacycles. Applicant has not indicated what oscillator circuit may be used. All sawtooth oscillators are not operable at this frequency. (Item I, page 17).
>
> "The disclosure does not therefore comply with 35 U.S.C. 112 and is an invitation to experiment. See In re Beach 68 U.S.P.Q. 196." (Item I, page 18).

This is all he said.

After requesting reconsideration (Item I, page 18), Hirsch then submitted an affidavit November 5, 1957, (Item I, page 27) stating as follows:

> "I am an electrical engineer of some thirty years' continuous experience in the field of radio and television. This experience has comprised continuous activity in the design and manufacture of numerous types of electronic equipment employing saw-tooth oscillators, for example, television and radar equipment. Saw-tooth oscillators have been conventional elements of such equipment for two decades.

"For at least the last fifteen years it has been well within the competence and knowledge of the average electronics engineer working within the fields of television and radar to design saw-tooth oscillators operable at the frequency indicated in my above-identified application. For example the constructions indicated in my attorney's REMARKS on October 22, 1957, with reference to the Article in the Proceedings of the Radio Club of America, Volume 26, No. 1, 1949, and in Radio Engineering by Terman, 1947, may be utilized by such an engineer for that purpose and he would have no difficulty making such constructions operate at the frequencies I have indicated in my application."

The Examiner did not comment on the affidavit at this stage of the proceedings.

Hirsch then filed his appeal to the Patent Office Board of Appeals, having no other remedy in view of the final nature of the Examiner's action.

In his "ANSWER" to the Board of Appeals (answering Hirsch's brief to the Board of Appeals) the Examiner defended his position by stating (Item I, pages 28 and 29) that he could not find such a generator in the literature available in his office and dismissed the Hirsch affidavit on the ground that it was "a statement of opinion", intimating that Hirsch should show that such a generator had actually been built.

The Board of Appeals affirmed the Examiner indicating that it was Hirsch's duty to show that the challenged 2 megacycle capability of the generator was "conventional in the prior art" (Item I, page 31).

This is essentially all that the Patent Office said on the issue involved. It produced no evidence indicating

why such capability was not within the skill of the art, not even its own reasons for doubting it. Neither did it explain why any of Hirsch's assertions were supposedly incorrect. Nor did it attack Hirsch's credibility. Both the Examiner and the Board merely indicated that they were not convinced.

The fact that the issue did not arise until the hurried final rejection and belated criticism of the affidavit made it impossible for Hirsch to submit further evidence since the case was then in the appeal stage. Neither could he amend his application without losing the benefit of his priority rights based on the filed date of his application. But even if he had been permitted to submit further evidence or amend his application, all this placed upon Hirsch the burden of searching endless technical literature to find a numerical statement which no engineer would think important enough to put in print unless he was particularly concerned with frequency. The fact that the Examiner could not find it is evidence of its unimportance.

As the application states, (Item I, page 7) sawtooth generators are conventional. In fact, the sawtooth generator has been a well known tool in television for many, many years, as Hirsch stated in his affidavit.

Neither the Examiner nor the Patent Office Board of Appeals challenged the fact that sawtooth generators are well known; they tacitly admitted it, as indeed they must. The Court of Customs and Patent Appeals also conceded it (Item IX, page 5). Rather, the rejection was based on the narrow point that the Examiner did not believe sawtooth generators are available which would be capable of operating at 2 megacycles (Item I, pages 17, 28, 29). Both the Examiner and

the Board of Appeals indicated at numerous points in the record that it is this 2 megacycles capability which governed their thinking (Item I, page 31). For example, the Examiner's Answer, as indicated above, intimates that his basis of rejection is the mere fact that he could not find in his file a reference actually specifying numerically a frequency as high as 2 megacycles (Item I, page 28).

The Court of Customs and Patent Appeals in affirming indicated that it was following the arbitrary standards of the Patent Office which required that the applicant find the challenged 2 megacycle capability in a printed publication, or show that it is conventional, or alternatively, that applicant specify the component values of his generator which would bring about the required capability so as to relieve those who wished to use the invention of any burden of designing the generator.

This conclusion as to the Court's view is to be drawn from the following remarks and quotations made with apparent or express approval:

> "It will be observed that there is lacking here, as it is lacking throughout this case, any assertion *that the publications* disclose a saw-tooth generator operable at or above 2 mc. (Item IX, Opinion, page 4—emphasis ours).
>
> "A search was made in the *literature* available in Division 16 (now in Div. 41) and in Class 250, subclass 36 for a generator operable in this frequency range. The highest frequency found mentioned for such a generator was *200 kilocycles.* (Item IX, Opinion—page 5—quoting Examiner—first emphasis ours).
>
> "Where a device is presented in an application essentially only by means of a labeled rectangle,

with no other description or illustration of specific circuitry, *it must be one of known conventional nature* in the prior art in order that such presentation be regarded as a sufficient disclosure. Ex Parte *Sziklai*, 110 USPQ 325 [Bd.] (Item IX, Opinion, page 6, quoting the Board of Appeals—first emphasis ours).

"If he could not cite any references in the *literature* establishing the '*conventional*' construction of his 2 mc. saw-tooth signal generator, as he asserted it to be, he should have been able to describe it to the examiner. (Item IX, Opinion, pages 6, 7—emphasis ours).

"If he was not in a position to take one of the four very simple circuit diagrams cited, showing lower frequency (100 KC) generators, and supply the component values (parameters) which would make it operate at the required frequency of 2 mc. or higher, then he had not completed his invention. (Item IX, Opinion, page 7).

"We agree with the view of the board that the applicant did not meet 'the burden imposed upon him by what seems to us to be a reasonable criticism made by the examiner'. It was the examiner's duty to compel a disclosure which would enable those skilled in the art to practice the invention without having *to design* circuitry not shown to be readily available in the art." (Item IX, Opinion, page 7).

The two dissenting Judges, Martin and Smith, took essentially the view advocated by the petitioner. Judge Martin said:

"It seems to me that, in order to maintain the position that this application does not comply with 35 USC 112, the examiner and the board should also have stated categorically that the information contained in the pages submitted by appel-

lant was not sufficient to teach one skilled in the art *how to make* a 2 megacycle saw-tooth generator. Further, they should have stated why that is true. It may be that a saw-tooth generator operable at 2 megacycles differs in kind from one operable at 100 or 200 kilocycles, but that fact has not been stated in the record and I do not feel moved to assume that it is or is not true.

"Indeed, the examiner's final rejection and answer and the board's opinion do not convince me that one skilled in the art could not construct the required saw-tooth generator with the knowledge of the reference pages and affidavit submitted by appellant." (Item IX, page 2 of Judge Martin's opinion).

Judge Smith said:

"It seems to me that where the issue here is essentially one of the correctness of technical assertions made, the affidavit of Hirsch as to what one skilled in the television art would know from the disclosure is entitled to greater credence than has been assigned to it in the majority opinion. The affidavit verifies that the disclosure teaches enough so that one skilled in the television art could make and use the invention. An application addressed to 'any person skilled in the art' should be tested by what it discloses to such a person, the best evidence of which, on the record before us, is the affidavit of applicant." (Item IX, page 2 of Judge Smith's opinion).

Indeed, Judge Smith took the most unusual step of finding on his own initiative evidence of 1 megacycle generators in the literature (footnote 1, Item IX, page 1 of Judge Smith's opinion). The footnote reads:

"It is noted that while the examiner's search discovered only a saw-tooth generator operable at

200 kilocycles as quoted in the majority opinion, the *Electrical Engineers' Handbook*, 4th ed. (1950), by Pender and McIlwain indicates that a multivibrator type saw-tooth generator might be made to operate up to 1,000,000 cycles (1*MC*). While this does not necessarily indicate that a person skilled in the art could readily construct a 2,000,000 cycle (2*MC*) saw-tooth generator, it suggests caution in the use of the examiner's failure to find a reference above 200,000 cycles as the sole basis upon which to decide what the disclosure in question teaches one skilled in the art."

Lastly—as a prejudicial irregularity—we point to Hirsch's motion in the Court of Customs and Patent Appeals to strike portions of the brief for the Commissioner of Patents as prejudicial (Item IV). The story behind this is that the Commissioner of Patents had insinuated in his brief that essential portions of the Patent Office record were missing. Hirsch demanded either that the offending portions of the brief be stricken or that the Commissioner of Patents produce the supposedly missing portions, Hirsch denying that any relevant portions were missing and asserting that the omitted portions all had to do with pure formalities or objections of the Examiner, having nothing to do with the issue of this case and which were withdrawn by the Examiner and acknowledged as withdrawn by the Board of Appeals. Upon opposition of the Commissioner of Patents (Item V) expressly acknowledging and expressly declining to exercise his right to move to correct diminution of the record, this motion of Hirsch was denied (Item VII). Later, the Court of Customs and Patent Appeals in its opinion also prejudicially insinuated (Item IX, pages 2 and 5) that pertinent portions of the record were missing.

Hirsch thereupon moved (Item XI, page 5, Item XII, Items XIII and XIV) contemporaneously with his Petition for Rehearing that he, himself, be permitted to produce all omitted portions of the Patent Office record to show that they were indeed irrelevant and thereby to remove the prejudicial cloud over his case, even though it was the duty of the Patent Office to produce any omitted portions it thought relevant. Upon opposition of the Commissioner of Patents (Item XV) this motion, too, was denied (Item XVI).

Thus, the situation is that the Commissioner of Patents deliberately created a prejudicial cloud, refused to justify it as was his duty, and fought the efforts of Hirsch to expose it. And the Court of Customs and Patent Appeals perpetuated it in its opinion.

The record is indeed "very abbreviated" (Item IX, page 2). But it is in the sense that it is short, not incomplete. There was no such thing as "appellant's extreme abbreviation of the record" as the Court of Customs and Patent Appeals prejudicially remarked (Item IX, page 5). The Examiner failed to make any more record than that presented here and in the Court of Customs and Patent Appeals.

REASONS FOR GRANTING THE WRIT

1. The Arbitrary Treatment of Hirsch Exemplifies an Issue of Imperative Public Importance.

2. Arbitrary Exercise of Power by an Administrative Agency Is an Issue of Imperative Public Importance.

This case presents an issue of "imperative public importance" to use the language of this Court's Rule 20.

This case presents a situation where the Court of Customs and Patent Appeals "has so far departed

from the accepted and usual course of judicial proceedings, and so far sanctioned such departure by a lower court as to call for an exercise of this Court's power of supervision", to use the language of this Court's Rule 19.

This Court is not being asked solely to reverse a factual determination. It is being asked to examine and reverse the arbitrary abuse of statutory law and the rules of evidence. The facts are here only to show the arbitrary abuse.

It is of imperative public importance that inventors not be arbitrarily deprived of statutory rights by unjustified enlargement of the statutory burden of 35 USC 112 that they disclose to "enable any person skilled in the art * * * to make and use the same"—particularly where the Patent Office has remained totally silent, both as to evidence of its own to support its initial assertion, as to evidence to refute that of Hirsch, and as to evidence impugning Hirsch's credibility.

The Court of Customs and Patent Appeals has "so far departed from the accepted and usual course of judicial proceedings" that it has not only enlarged the statutory burden but it has also ignored the accepted and usual legal practice of judging by the preponderant weight of the evidence. Else why should it have added the additional burdens indicated above that the challenged 2 megacycle capability be found in a publication, or that it be conventional, or that the applicant spell out specific component values? Else why did it completely ignore the Patent Office silence in the matter of evidence? Else why did it pick up and repeat prejudicial insinuations of the Patent Office

that the record was incomplete when it was the duty of the Patent Office to support the insinuations—and certainly not to oppose Hirsch's efforts to expose them?

We submit that cases of this kind should be decided not on the all too abused presumption of Patent Office expertise but on the normal basis of weighing the preponderance of evidence.

The presumption that the Patent Examiner is an expert is an over simplification of very limited accuracy. It loses touch with reality when applied rigidly to the point where he is beyond challenge and his theorizing outweighs assertions of real experts from industry and, particularly, when applied to the point where Examiner is relieved even of the burden of explaining his objection.

As the District Court for The District of Columbia has recently stated in a similar situation:

> "* * * if the Patent Office wishes to discredit expert or lay testimony, the obvious method would be to provide witnesses for that purpose." *General Radio Company* v. *Watson*, 188 F. Supp. 879; 125 USPQ 268, 274; DC, DC 1960.

In short, cases such as this should be based on something more than an Examiner's suspicion that the device will not work.

The latter is apparently the view of dissenting Judges Martin and Smith.

It is, presumably, also the view of Dean James M. Landis who, in writing on "The Administrative Process" in the American Bar Association Journal of February 1961, page 136, criticized this tendency to overrate administrative expertise with the statement:

"'Now, however, a third stage in administrative development seems to be taking place. Its rumblings have been apparent for some time. Some of them have now been brought to light by the work of the House Committee on Legislative Oversight. We are or, at least, we should be examining the truth of certain legends that during these years have been built up about the administrative process. Let me name some of them.

"The first of these is the legend of its possession of expertise—a phrase that I think derives from Harold Laski. It was a nice phrase for the defenders of the administrative process and it had value in demonstrating to the judiciary, generally unfamiliar with the economics of a particular problem, that the solution of that problem, if at all reasonable, should be left to persons who were presumably familiar with it. It probably had merit in the days when Judge Cooley, Commissioners Eastman and Mahaffey sat on the Interstate Commerce Commission. It may have considerable merit today in many specific situations. But on the whole does it exist? It exists obviously in the staffs of many of our agencies. But at the top level, where the responsibility of decision rests, one cannot be too sure. * * *"

So, too, Earl W. Kintner, Chairman of the Federal Trade Commission, who, writing on "Federal Administrative Law in the Decade of the Sixties" in the American Bar Association Journal for March 1961, page 270, picked up the same theme and wrote:

"* * * But on the whole does expertise exist in the agencies? It exists obviously in the staffs of many agencies. But can we truthfully say that those who bear the responsibility of decision truly possess it in the expected measure?

"The obvious and sorrowful answer must be 'no'. One of the reasons compelling this answer

involves the selection of agency members. Another reason, equally important, involves the failure by agency members to justify claims of expertness that are well deserved, for only those who reason and explain and justify can support a claim of expertness.

"Many voices have been raised in opposition to the institutional decision. To these I add my own. The consideration that impersonal mass injustice often produces individual unfairness is reason enough to take such a position, but there is another reason as well—one connected with the health of the administrative process. Only articulate, personal rationalization of decisions can guarantee that personal experience has been brought to bear on an issue. Only reasoned support for a position carefully explained can bring true public confidence in the fairness of the decision. Further, bare findings of fact accompanied by an order do not serve to explain the law and educate those who must comply with the law. If the business community subject to regulation can find no rationalization upon which to base expectations and make plans, then it is no wonder that claims of arbitrariness, of ineptness, and—yes—of outright dishonesty should be heard in the land. The function of the expert is to explain. No one can be an expert who does not explain."

Patent Office Examiners ought not to be beyond challenge. Yet in practice they all too frequently enjoy that advantage. Indeed, it is the Patent Office position that an inventor may not even demand that the Examiner state his qualifications to speak as an expert. That issue was raised contemporaneously with this case in an appeal to the Board of Appeals of the Patent Office, *Ex Parte Donald Richman*, Appeal No. 479-91.

In that appeal there was a prolonged dispute between the Examiner and highly qualified television experts on hypertechnical engineering issues. The applicant requested the Examiner to state his qualifications to speak as an expert but he declined to do so on the ground that this was challenging the Examiner's right to criticize and perform his job. The Examiner's viewpoint was sustained by the Board of Appeals.

One may be excused for asking a question which should answer itself. Where does the real knowledge of our highly scientific arts like television reside—in the men who sweat out its problems in our laboratories and on our factory floors—or in the paper files of the Patent Office? It is just not possible for an examiner, who is, of necessity, a follower of the art and whose function is more that of a quasi judge or lawyer than an engineer, to keep informed as to the intimate knowledge of engineers and scientists in that advanced twilight zone between the "known" and the "new".

This Hirsch case is before this Court as an example of the all too common abuse of administrative power which works extensive injustice in industry at its lowest working levels—at the level of the little yet essential problems which breathe vitality into any industry. In this area, the unreasoned fiat of a lowest level Hornbook learned administrative agent on highly specialized minor technological questions which, in fact, are only within the knowledge of practical industrial specialists on the factory floor, burgeons into a high level legal dispute and does much damage to industry. The very working level nature and frequency of occurrence of these situations make it difficult to combat the arbitrary actions. Economic con-

siderations often force abandonment of the contest and statutory rights since, obviously, all such controversies can not economically be contested as high as this Court or indeed as high as the Patent Office Board of Appeals. It is of imperative public importance to the health of industry that this situation be corrected.

3. An Interpretation of 35 USC 112 Is of Imperative Public Importance.

4. In Conflict With Decisions of This Court, 35 USC 112 Has Been Construed to Add Burdens Not Authorized by Congress.

The meaning of 35 USC 112 is of great public importance. To the scientists, industrialists and ordinary inventors who use it as a medium "to promote the progress of science and useful arts" in accordance with Article I, Section 8 of the Constitution, it is a vital thing. They must know what Congress meant them to do and what Congress meant the Patent Office not to do.

This Court has stated clearly that statutes may not be enlarged beyond their plain meaning. In *Caminetti v. United States*, 242 US 470, this Court said:

> "It is elementary that the meaning of a statute must, in the first instance, be sought in the language in which the act is framed, and if that is plain, and if the law is within the constitutional authority of the law making body which passed it, the sole function of the courts is to enforce it according to its terms. * * *
>
> * * * * * * * * *
>
> "Statutory words are uniformly presumed, unless the contrary appears, to be used in their ordinary and usual sense, and with the meaning commonly attributed to them. * * *" (pages 485 and 486).

The defendant in *Caminetti* contended that although the act in question was clear, it should be interpreted to add the qualification "for hire," since that was the intent expressed in the report which introduced the Act to Congress for passage. To this, this Court answered:

> "* * * Still, the name given to an act by way of designation or description, or the report which accompanies it, cannot change the plain import of its words. If the words are plain, they give meaning to the act, and it is neither the duty nor the privilege of the the courts to enter speculative fields in search of a different meaning.
>
> "Reports to Congress accompanying the introduction of proposed laws may aid the courts in reaching the true meaning of the legislature in cases of doubtful interpretation * * *. But, as we have already said, and it has so often been affirmed as to become a recognized rule, when words are free from doubt they must be taken as the final expression of legislative intent and are not to be added to or subtracted from by considerations drawn from titles or designating names or reports accompanying their introduction, *or from any extraneous source*. In other words, the language being plain, and not leading to absurd or wholly impractical consequences, it is the sole evidence of the ultimate legislative intent." (page 490) (Emphasis ours).

In *Yates v. United States*, 354 US 298, 1 L. Ed. 2d 1356, 77 S. Ct. 1064, this Court said:

> "* * * The intention of the legislature is to be collected from the words they employ. Where there is no ambiguity in the words, there is no room for construction. The case must be a strong one indeed, which would justify a Court in depart-

ing from the plain meaning of words, especially in a penal act, in search of an intention which the words themselves did not suggest. *To determine that a case is within the intention of a statute, its language must authorize us to say so* * * *." (354 US at 305) (Emphasis ours)

* * * * * * * * *

"* * * We too think this statute should be read 'according to the natural and obvious import of the language, *without resorting to subtle and forced construction for the purpose of either limiting or extending its operation.*' *United States* v. *Temple*, 105 US 97, 99, 26 L. Ed. 967, 968." (354 US at 311). (Emphasis ours).

Returning, now, to the Statute 35 USC 112, its standard is clear however broad. It merely requires a showing that the challenged 2 megacycle capability is something which one skilled in the art would be able to think out for himself with the knowledge in his mind as the result of the normal experience of his art. Nothing is said about whether those skilled in the art should be able to find a particular fact in a printed publication, or that it be conventionally available to them, or that the inventor give precise specifications of component values, or that he relieve those skilled in the art of any burden of designing tools. If, indeed, the apparent requirements of the Court of Customs and Patent Appeals and the Patent Office in these respects are correct, there would be no need for Congress to have laid down the "skilled in the art" test of 35 USC 112.

This Court has spoken before on the subject:

"* * * Webster's patent must have been perfectly intelligible to them. When an astronomer reports that a comet is to be seen with the tele-

> scope in the constellation of Auriga, in so many degrees of declination, and so many hours and minutes of right ascension, it is all Greek to the unskilled in science; but other astronomers will instantly direct their telepscopes to the very point in the heavens where the stranger has made his entrance into our system. They understand the language of their brother scientist. If a mechanical engineer invents an improvement on any of the appendages of a steam engine, such as the valve-gear, the condenser, the steam-chest, the walking-beam, the parallel motion, or what not, he is not obliged, in order to make himself understood, to describe the engine nor the particular appendage to which the improvement refers, nor its mode of connection with the principal machine. These are already familiar to others skilled in that kind of machinery. He may begin at the point where his invention begins, and describe what he has made that is new, and what it replaces of the old. That which is common and well known is as if it were written out in the patent and delineated in the drawings." *Loom Company* v. *Higgins* (1881), 105 U.S. 580, pp. 585, 586.

Thus the Court of Customs and Patent Appeals and the Patent Office appear to reject the thought that the references which Hirsch supplied to show conventional sawtooth generators need only show enough to permit one skilled in the art to design a 2 megacycle generator. If so, both were reading more into 35 USC 112 than it says. More, indeed, than the Court of Customs and Patent Appeals required in *In Re Chilowsky*, 229 F(2) 457, 43 CCPA 775, 108 USPQ 321, in which that Court was presented with the same problem as in this case and said:

> "It is true that many of the procedures and material suggested by appellant's application are

identified in general terms, and that exact proportions and amounts are left for determination by those skilled in the art. This would not be a fatal defect if it appeared that those skilled in the art possessed the necessary knowledge to make the required determination. *On that point, very little actual information has been provided either by the appellant or the Patent Office tribunals; the appellant merely asserting that certain knowledge was available in the art, without pointing out where it could be found, while the examiner and the board relied upon general statements that commercial reactors had not been built at the time appellant's application was filed.* The mere fact that something has not previously been done clearly is not, in itself, a sufficient basis for rejecting all applications purporting to disclose how to do it.

* * * * * * * * * *

"Thus, in the usual case where the mode of operation alleged can be readily understood and conforms to the known laws of physics and chemistry, operativeness is not questioned, and no further evidence is required. * * *

* * * * * * * * * *

"The present case does not appear to be of either of the two types last mentioned. On the contrary, it was stated by the Board that 'the basic laws governing atomic fission are known,' and it should, therefore, be possible to test the application disclosure by those laws. *Under such circumstances, we do not consider that a broad allegation that the application disclosure is speculative*, coupled with a recitation of various difficulties which might be encountered in attempting to put it into practice, and a further assertion that there might be still other difficulties which could not be foreseen, constitutes a sufficiently definite statement of a basis for rejection. * * *" (108 USPQ 325) (Emphasis ours)

Lastly, we think Judge Learned Hand's remark in *Reiner* v. *I. Leon Co., Inc.*, 2 Cir. 1950, 285 F(2) 501, 128 USPQ 25, 27, is very apropos of the problem here. He said:

> "* * * To judge on our own this or that new assemblage of old factors was, or was not, 'obvious' is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it * * *."

We think Hirsch was far more familiar with the minutiae of sawtooth generators than the Patent Office.

To sum up—35 USC 112 does not place upon Hirsch any of the burdens imposed by the Court of Customs and Patent Appeals and the Patent Office, indicated by the QUESTIONS PRESENTED above.

> "To determine that a case is within the intention of a statute, its language must authorize us to say so." (*Yates* v. *United States*, above).

Neither the Court of Customs and Patent Appeals nor the Patent Office can find in the language of 35 USC 112 a Congressional intention authorizing the arbitrary standards imposed upon Hirsch.

No law requires Hirsch to show that others had made and operated sawtooth generators at a frequency of 2 megacycles in order to make him eligible to be granted a patent. And, lastly, it was the burden of the Patent Office to produce any portions of the record it deemed missing and relevant to its position; the Court of Customs and Patent Appeals was prejudicial to Hirsch in insinuating in its opinion that relevant portions were missing.

We think, therefore, that Hirsch has been the victim of arbitrary action which this Court should correct.

CONCLUSION

For the foregoing reasons, this petition for a Writ of Certiorari to the Court of Customs and Patent Appeals should be granted.

Respectfully submitted,

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